



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/226,467	01/07/1999	ROBERT N. FALCO		1025

23413 7590 11/23/2001

CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
----------	--------------

2837

DATE MAILED: 11/23/2001

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MAILED

NOV 19 2001

GROUP 2800

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 24

Application Number: 09/226,467
Filing Date: January 07, 1999
Appellant(s): FALCO, ROBERT N.

Bedingfield
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 10/01/2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: ***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-13 and 16-23.

The rejection of claims 14 and 15 is hereby withdrawn in view of the Applicant's argument in the Appeal Brief.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Art Unit: ***

Appellant's brief includes a statement that claims 1, 7, 13-16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,253,452	Powers et al.	9/1991
4,936,411	Leonard	6/1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13 and 16-23 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 19.

(11) Response to Argument

In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Further, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

Art Unit: ***

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In Leonard, the detectable insert always has to be encapsulated with the body of the earplug. One may even use the detectable earplug without the need of a cord. See Leonard, column 2, lines 22-25. The earplugs of Powers et al. are made from slow recovery foam and therefore, the material around hole 26 is permitted to close under the influence of the recovery rate to surround the detectable insert. "A characteristic of the foam material is that upon distortion by the application of a force thereto the foam material is temporarily remains distorted and the slowly recovers its original shape. See Powers et al., column 2, lines 35-38. With regard to claim 13, it is clear that in Powers et al., a channel is formed by inserting a punch in the slow recovery foam body. With regard to claim 16, it is also clear that in either manual or automation manufacturing process the detectable insert must be projected into the foam body at a predetermined trajectory and speed to ensure that the insert is within the foam body, and then the characteristics of the foam material of Powers et al. would allow the foam body to encapsulate the insert so that the foam body completely surrounds the insert.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/226,467

Page 5

Art Unit: ***

Respectfully submitted,

Khanh Dang

kd

November 16, 2001

KHANH DANG
PRIMARY EXAMINER
GROUP 2100

CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

Conferees

Robert Nappi
Spe 2037

[Signature]

Khanh Dang

107

Khanh Dang

[Signature]

Arthur T. Grimley
Supervisory Patent Examiner
Technology Center 2800